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09/991,356	11/19/2001	Manjit Chowdhary	ECO530/4-2DIVUS	4178

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

991 356

Applicant(s)

CHOWDHARY

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 26 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claim Interpretation

1. Claims 18 and 20 are interpreted to be directed to “the guar gum powder product” as stated at the beginning of the claim, and not the host product. The host product is not being claimed, since the claims are directed to the guar gum powder product. If applicant puts the claims in the form of claiming the host product such as drilling fluid, fracturing fluid, animal litter etc. , then such would be subject to a restriction requirement and election of species.

Claim Objections

2. Claims 2, 10 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claims 1 and 24, guar gum splits must contain polygalactomannan and thus fail to further limit the parent claims. In claim 10, (1) and (2) are the same, and thus the claim is of the same scope as claim 9.

3. Claim 10 is objected to because of the following informalities: Both (1) and (2) are the same. Appropriate correction is required.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975).

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held, such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground

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guar from guar splits, than guar not subject to extruding or flaking. Rutenberg also differs in not specifying an extruding barrel of 2 - 8 inches, or the use of chemically or genetically modified guar. The utility of barrels of differing size, in order to optimize the processing of the guar would be an obvious variation to one of ordinary skill in the art (In re Rose 105 USPQ 237).

Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 11-15, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

6. Claims 1, 3, 4, 23, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975) in view of Dino (5646093), Harris (5990052) and Applicants specification.

Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a

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gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Moisture content and mesh size which are the same as the present invention are disclosed at column 4, lines 1-4 and lines 44-49. Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. The courts have held, such as In re Crockett 126 USPQ 186, that combining such methods would not be patentable, since it would logically flow that the combination would produce the same effect, and would supplement each other. It would thus be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art. In support of such knowledge in the art, Dino in Example 1, and Harris at column 8, lines 35-37 teach the use of guar splits to form chemically modified guar products which are used in operations such as oil well drilling and fracturing. Applicants specification at page 9, lines 15-27 clearly teach that it is known in the art to chemically modify guar gum, and genetically modify plants in order to produce the guar products, thus such variations would be obvious variations to one of ordinary skill in the art.

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Although Rutenberg does not teach the hydration rate properties at specific temperatures disclosed in claims 41-70, the mere discovery of a property of an obvious composition has been held to not alone render patentability by the courts. In re Dillon 16 USPQ2d 1897 states "but discovery that claimed composition possesses property not disclosed for prior art does not alone defeat a prima facie case, and it is not necessary, in order to establish prima facie case, to show both structural similarity between claimed and prior art compound and suggestion in, or expectation from, prior art that claimed compound will have the same or similar utility as one newly discovered by applicant". Thus applicants mere discovery of the property of hydration rates at specific temperatures does not render patentability to the composition.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2835
June 27, 2003


PHILIP C. TUCKER
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